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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/296,582 04/23/99 PEERY

J 000952066

EXAMINER
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021839 QM12/0406  
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MAYNARD, J. ART UNIT	PAPER NUMBER
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3763  
DATE MAILED:

04/06/01

b

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/296,582

Applicant(s)

PEERY, JOHN R.

Examiner

Jennifer J Maynard

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-17 is/are rejected.
- 7) ☐ Claim(s) 4-6 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 5.
- 18) ☒ Interview Summary (PTO-413) Paper No(s) 6.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to a trocar, classified in class 604, subclass 60.
- II. Claim 18, drawn to a method of using a trocar, classified in class 604, subclass 506.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method as claimed may be performed by a different apparatus not requiring the structural particularities claimed by applicant, such as a pellet gun or subcutaneous implanter.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Cindy Lynch on 29 March 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-17.

Affirmation of this election must be made by applicant in replying to this Office action. Claim 18 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

✓ Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Muir-‘158.

Muir discloses an instrument for implanting radon seeds comprising an implanter (1), a trocar (2), a plunger (3) and a spring member (20). The implanter includes a tubular body portion (4) and a needle (5) which together define a bore (6), the trocar is defined as a rod having a sufficiently small diameter such that when inserted within the bore defined by the tubular body and the needle of the implanter it results in a tight fit, the plunger is defined as a thin rod having an outside diameter significantly smaller than the bore, and the spring member (20) communicates with the bore of the tubular body and the needle of the implanter so as to hold a radon seed within the bore prior to ejection via the plunger thereby resulting in implantation.

Claims 1, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Harmon-‘671.

Harmon discloses a device for implanting articles under the skin comprising a push rod (11), a syringe-like tubular body (50) having an interior wall (54) and an integral hollow needle (60) on the distal end of the tubular body, and an insert comprising three friction ribs (58)

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mounted on the interior wall of the tubular body and capable of frictionally receiving the implant so as to hold the implant in place prior to the push rod expelling the implant from therein.

Claims 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Utterberg-‘259.

Utterberg discloses a hypodermic cannula comprising a tube having a sharp end formed by a first cut surface (12) defining an acute angle to the longitudinal axis (14) of the tube and forming a generally oval tube edge, and a second cut surface (20) is defined along a right hand forward portion of the oval tube edge (16) and being made at a different acute angle to the axis (14). The cutting point and all the forward cutting edges are spaced inwardly from the cannula outer wall thus exhibiting extreme incision sharpness for maximized patient comfort and also protection from hematomas, see Column 1, lines 51-57.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muir-‘158 in view of Utterberg-‘259.

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Muir discloses the invention as claimed with the exception of the cannula having two cutting surfaces.

Utterberg discloses a cannula having two cutting surfaces.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the cannula of Muir with the cutting tip as taught by Utterberg so as to provide the cannula with a cutting point and forward cutting edges which are spaced inwardly from the cannula outer wall thereby allowing the cannula to exhibit extreme incision sharpness for maximized patient comfort and also to protect against the development of hematomas.

#### *Allowable Subject Matter*

Claims 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Schlegel et al.-'769 discloses a cannula for the subcutaneous deposition of an object comprising a lumen constriction (28) that can be created in a number of ways, e.g. dimpling the cannula wall or providing a bead running at least part way around the lumen, thus reducing the cross section of the cannula lumen at one specific point along the cannula's length so as to clamp the object (26) to be implanted therebetween prior to being selectively expelled via a slidable mandrin (24).

Campbell et al.-'384 discloses an animal marker implanting system comprising a projection (29) integral with sleeve (25) which extends through an opening (28) in order to prevent the implantable marker from slipping or moving within the tube prior to discharge.

Suzuki-'545 discloses a catheter insertion device comprising an inner needle (1) formed into an odd-shaped cylinder having longitudinally cut halves, only one half of which is tapered and has a slightly crushed shape, the needle has a beveled surface (1a) which is created by cutting the slightly crushed half of the odd-shaped cylinder (1b) larger than the other half which has a semicircular cross-section.

Sandhage et al.-'406 discloses a pellet implanter comprising a cover clip (53) having molded therein a series of discharge apertures (55), each generally large enough for the discharge of the pellets in the chamber, but having formed therein flexible pellet-retaining leaves (56). These leaves are sufficiently thin and flexible that they may be easily displaced on injection of the pellet but are sufficiently rigid to retain the pellets in position during storage until the time of injection.

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Harris-'072 discloses a surgical applicator comprising jaws (f) at the distal end of a tube (a) for the purpose of retaining the medicine within the nozzle of the tube (a) until discharged by the plunger (b).

Nicholson-'070 discloses an implantation gun comprising a spring finger (12) secured by one end to the barrel (5) and the free end extending into the barrel bore (11), so as to prevent pellets to be implanted from falling out of the barrel.

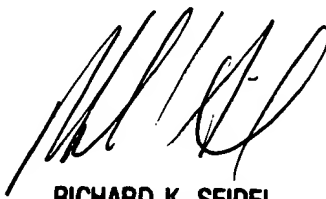
Any inquiry concerning this communication should be directed to Examiner Jennifer Maynard at telephone number (703) 305-1356. Examiner Maynard can normally be reached at the above number from Mon-Fri. 7:30 A.M. to 5:00 P.M.

If attempts to reach Examiner Maynard are unsuccessful, the examiner's supervisor Richard Seidel can be reached at 703-308-5115. The fax number for this unit is 703-305-3590.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist at 703-308-0858.

J Maynard *J Maynard*

March 29, 2001

  
RICHARD K. SEIDEL  
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